

[Handwritten signature]



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,461	12/21/2000	John E. Schier	062891 . 0490	2553

7590
Kevin J. Meek, Esq.
Baker Botts L.L.P.
2001 Ross Avenue
Dallas, TX 75201

07/29/2005

EXAMINER

HO, THOMAS M

ART UNIT	PAPER NUMBER
----------	--------------

2134

DATE MAILED: 07/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/745,461

Applicant(s)

SCHIER, JOHN E.

Examiner

Thomas M. Ho

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2005.
2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-21 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/30/04.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-21 are pending.

Double Patenting

2. Claims 1-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,907, 123.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-21 are rejected under the judicially created doctrine of double patenting over claims 1-11 of U. S. Patent No. 6,907,123 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

For clarity of the rejection, the Examiner will refer to each bulleted point as a numbered recitation.

Claim 1 of US patent 6,907,123 recites A method of communicating voice transmissions to a receiving device from a transmitting device, comprising:

- *Receiving a user input through a user interface associated with the transmitting device; (first claim recitation)*
- *Using an encryption key value to select an initial encryption algorithm from an encryption selection table stored at the transmitting device, the encryption key value calculated as a function of at least one or both of a periodic key value and a public key value, the user input comprising at least one of the encryption key value, the periodic key value, or the public key value. (second claim recitation)*
- *Encrypting the initial voice transmissions from the transmitting device using the initial encryption algorithm, the transmitting device capable of encrypting voice transmissions using a plurality of encryption methods. (third claim recitation)*

- *Transmitting the encryption initial voice transmissions from the transmitting device.*
(fourth claim recitation)

Claim 1 of the current application recites:

A method for communicating a data message, comprising:

- Selecting a table key value in an encryption selection table based on an index that is a function of a periodic key value and a public variable key value, the encryption selection table specifying at least one of plurality of encryption methods to be used to encrypt a data message, the table key value associated with at least one of the plurality of encryption methods: (rejected over the second recitation of claim 1)
- Encrypting the data message using the encryption method associated with the table key value; (rejected by third recitation of claim 1)
- Transmitting the encrypted data message over a data communication network. (rejected by fourth recitation of claim 1)

While claim 1 of US patent 6,907,123 does not explicitly disclose transmitting the encrypted data over a data communication network, it recites transmitting voice transmissions between a receiving and transmitting device. It would have been obvious to one of ordinary skill in the art at the time of invention to set the receiving and transmitting device as part of a communications network.

Claim 7 of US patent 6907123 recites:

A telecommunications device operable to send and receive encrypted voice communication through a public switched telephone network, the device comprising:

- *A central processing unit operable to receive a user input through a user interface; (first recitation)*
- *An encryption decryption engine operable to execute a plurality of encryption methods under the control of the central processing unit (second recitation)*
- *An encryption selection table accessible to the central processing unit, the encryption selection table accessed using an encryption key value, the encryption selection table specifying at least one encryption algorithm associated with each of the encryption key values; and the device operable to: (third recitation)*
- *Encrypt voice communications using an initial encryption method associated with an indicated encryption key value; (fourth recitation)*
- *Transmit the encrypted voice communications through a public switched telephone network. (fifth recitation)*

In reference to claim 6:

A data communication device operable to transmit and receive data messages to and from a data communication network, the device comprising:

- A central processing unit operable to interface with user of the device through a user interface; (rejected over the first recitation of claim 7)

- An encryption decryption engine under the control of the central processing unit and operable to execute a plurality of encryption programs, each of the encryption programs being different than the remainder of the plurality and each of the encryption programs operable to receive a message and to output an encrypted message. (rejected over the second and third recitations of claim 7)
- An encryption selection table accessible using a key value, the encryption selection table specifying at least one of the plurality of encryption programs associated with each key value. (rejected over the second and third recitations of claim 1)
- A communication interface operable to transmit an encrypted message to the user of the device, the encrypted message encrypted using the at least one encryption program specified in the encryption selection table. (rejected over the third and fourth recitations of claim 1)

Claim 2 of US patent 6,907,123 as incorporating the limitations of claim 1 recites A method of communicating voice transmissions to a receiving device from a transmitting device, comprising:

- *Receiving a user input through a user interface associated with the transmitting device; (first claim recitation)*
- *Using an encryption key value to select an initial encryption algorithm from an encryption selection table stored at the transmitting device, the encryption key value calculated as a function of at least one or both of a periodic key value and a public key value, the user input comprising at least one of the encryption key value, the periodic key value, or the public key value. (second claim recitation)*

- *Encrypting the initial voice transmissions from the transmitting device using the initial encryption algorithm, the transmitting device capable of encrypting voice transmissions using a plurality of encryption methods. (third claim recitation)*
- *Transmitting the encryption initial voice transmissions from the transmitting device. (fourth claim recitation)*
- *Receiving a periodic key value at the transmitting device; (fifth claim recitation)*
- *Receiving a public variable key value at the transmitting device; (sixth claim recitation)*
- *Calculating an index value as a function of the periodic key and public variable key values. (seventh claim recitation)*

In reference to claim 15:

A method for communicating a data message comprising:

- Receiving a periodic key value and public variable key value at a communication device storing an encryption selection table; (rejected under fifth and sixth recitations of claim 2)
- Calculating an index from the public variable key value and the periodic key values using a pre-determined mathematical function (rejected under seventh claim recitation of claim 2)
- Selecting a table key value in the encryption selection table based on the calculated index, the encryption selection table specifying at least one of a plurality of encryption methods to be used to encrypt a data message, the table key value associated with at least

Art Unit: 2134

one of the plurality of encryption methods; (rejected under second and third recitations of claim 2)

- Encrypting the data message using the encryption method associated with the table key value; and (rejected under third recitation of claim 2)
- Transmitting the encrypted data message over a data communication network. (rejected under fourth recitation of claim 2)

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6,7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson, US patent 5185796.

In reference to claim 6:

Wilson discloses:

A data communication device operable to transmit and receive data messages to and from a data communication network, the device comprising:

- An encryption decryption engine under the control of the central processing unit and operable to execute a plurality of encryption programs, each of the encryption programs being different than the remainder of the plurality and each of the encryption programs operable to receive a message and to output an encrypted message. (Figure 5, Item 404) & (Column 4, lines 38-68)
- An encryption selection table accessible using a key value, the encryption selection table specifying at least one of the plurality of encryption programs associated with each key value. (Figure 5, Item 407, 408, 409) & (Column 4, lines 38-68)
- A communication interface operable to transmit an encrypted message to the user of the device, the encrypted message encrypted using the at least one encryption program specified in the encryption selection table. (Column 5, lines 10-25)

Wilson fails to explicitly disclose a central processing unit operable to interface with user of the device through a user interface;

The Examiner takes official notice that using a central processing unit to interface with the user of a device through a user interface was well known at the time of invention.

Using a CPU to interface with a user allows the user of a computer system to direct the actions he or she wishes the computer to perform. For example, typing data into a word processor to create this document is one such example.

It would have been obvious to one of ordinary skill in the art at the time of invention to include a CPU operable to interface with user through a user interface, in order to allow the user to direct control of computer system used in Wilson.

In reference to claim 7:

Wilson discloses a device wherein:

- The encryption selection table specifies a plurality of encryption methods to be used in sequence for each of the key values and wherein the encryption engine is operable to encrypt a data message using each of the plurality of encryption programs in sequence prior to transmitting the encrypted data message; (Figure 5) & (Column 4, lines 38-68)

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of the final action and the advisory action is not mailed under after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension pursuant to 37 CFR 1.136(A) will be calculated from the mailing date of the advisory action. In no event, however,

Art Unit: 2134

will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication from the examiner should be directed to Thomas M Ho whose telephone number is (571)272-3835. The examiner can normally be reached on M-F from 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A. Morse can be reached on (571)272-3838.

The Examiner may also be reached through email through Thomas.Ho6@uspto.gov

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-2100.

General Information/Receptionist	Telephone: 571-272-2100	Fax: 703-872-9306
Customer Service Representative	Telephone: 571-272-2100	Fax: 703-872-9306

TMH

July 21st, 2005

David Y. Jung
Primary Examiner

